

REMARKS

The Office Action requested affirmation of a provisional election to prosecute Group V (claims 31-64). The drawings and claims 50-51 were objected to. Claims 31-32, 34-37, and 51-52 were rejected under Section 102(e) as anticipated by Dodd (6,321,211). Further, claims 33, 38-40 and 53-54 were rejected under Section 103(a) as unpatentable over Dodd in view of Official Notice. In view of the amendments and the arguments below, Applicants submit that all claims overcome the objections/rejections and are in condition for allowance.

The Provisional Election

Applicants elect with traverse Group V – claims 31-64.

The Section 112 Objection

In view of the amendment to the drawing and to claims 50-51, Applicants submit that the informality objections/rejections are overcome. Withdrawal of the informality Objection/Rejection is requested.

The Section 102 Rejection

The Office Action rejected claims 31-32, 34-37, and 51-52 as anticipated by Dodd. The Office Action noted that:

In regards to claim 1, Dodd discloses a method for designating multiple recipients for an image at an on-line print service (FIG 1 C, select recipient.)

First the examiner would like to define what is understood to be applicant's envelope. The applicant defines on page 10 line 2 that "An envelope is a-virtual storage entity for holding images that are to be printed and delivered to a single destination". Microsoft Computer Dictionary defines a shopping cart as "a file in which an online customer stores information on potential purchases". Therefore the examiner considers the old and well known electronic shopping cart to be synonymous with the applicants envelope (see also col 1, lines 26-44), the method comprising:

creating a plurality of envelopes and displaying each envelope on a user interface (FIG. 1B and 1C);

associating with each envelope an intended recipient to receive images placed in a respective envelope (FIG 1 C, card image).

displaying on the user interface one or more images along with the plural envelopes (FIG 1C, card images) ;

selecting an image for distribution to multiple recipients (FIG 1 C); and associating a selected image with two or more envelopes (FIG 1C).

Applicants respectfully traverse the Section 102 rejection. Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). Here, Dodd fails to show a number of claimed elements and thus cannot anticipate the claims.

Dodd relates to a system that provides the ability for an online gift recipient to accept or exchange an online gift prior to shipping the gift to the recipient. While online with a gift server node (e.g. the gift server's website), a gift giver selects an online gift for the recipient from a variety of gifts supplied from one or more gift vendors. Information on the gift selection is sent to a gift queue on the gift server node while the recipient is notified of the gift, typically via an electronic mail message. In response to the notification, the recipient connects online to the gift server node, reads the gift selection information from the gift queue and determines whether to accept or exchange the gift. If the gift is to be exchanged, an electronic gift certificate is generated and another gift may be selected or different kinds of actual gift certificates may be selected as a replacement gift before an order for the initial gift is placed or the initial gift is shipped to the recipient.

Dodd relates to a conventional shopping cart ordering system with the ability for the recipient to accept or exchange gift. However, Dodd does not allow a user to select one or more pictures into one or more envelopes for printing, for example. As disclosed on pages 10-11 of the instant Specification:

The user can order prints of selected images for him/herself and/or for others by selecting the desired images and then associating them with one or more “envelopes.” An envelope is a virtual storage entity for holding images that are to be printed and delivered to a single destination. By default, the user’s “My Photos” page 1400 includes a single envelope – Self 1407 – corresponding to a destination associated with the user. As indicated, the user’s Self envelope 1407 currently has zero prints in it. The user can add prints to his/her envelope by selecting the desired image or images (e.g., clicking a thumbnail 1401 or a checkbox 1402) and then clicking the Add button 1415 (or, equivalently, the envelope icon 1416). Each additional click of the Add button 1415 will add another copy of prints of the selected images to the user’s Self envelope 1407 (e.g., clicking the Add button 1415 twice will result in ordering two copies of each of the selected images). The size of the ordered prints (e.g., 4x6, 5x7, 8x10, or custom size) can be selected by the user via the Size drop-down list 1411. The user can edit the contents of the Self envelope

1407 (e.g., the number and size of the prints ordered) by clicking the Edit link 1417 (discussed in more detail below).

The user also can add another envelope to the My Photos page 1400 by clicking the Add new envelope link 1408. Upon doing so, as shown in Fig. 15, the My Photos page 1400 changes appearance by adding another envelope 1500, which at this point has not yet been addressed to any particular recipient. The user addresses the unaddressed envelope 1500 by clicking on the Unaddressed1 link 1501, which causes the Address Your Envelope window 1600 to appear as shown in Fig. 16.

The Address Your Envelope window 1600 includes all of the potential recipients currently in the user's Address Book. The user can address the currently Unaddressed envelope 1500 by clicking on a desired one of the Nickname links 1602-1604, or the user can opt to add a new address to the Address Book by clicking the Add New Address link 1605. If the user decides not to add this new envelope after all, the unaddressed envelope 1500 can be deleted by clicking the Delete Envelope link 1606.

In this example, the user chooses to address the Unaddressed envelope 1500 to his father by clicking the Poppa link 1602. In response, the Address Your Envelope window 1600 is closed and the My Photos page is updated to change the name of envelope 1500 from "Unaddressed1" to "Poppa," as shown in Fig. 17. The user can now order image prints by selecting the desired images and clicking either the Self envelope 1407 or the Poppa envelope 1500 or both. In addition, different images or sets of images can be added to each envelope individually as desired. Moreover, each image in each envelope potentially can have different print parameters (e.g., size, finish, number of copies) specified by the user. In this manner, the My Photos page 1400 shown in Fig. 17 allows the user to designate multiple recipients through a single interface screen (e.g., page 1400) and/or within the context of a single order (e.g., as delimited by a checkout sequence). As a result, the efficiency and ease with which image prints can be ordered and delivered to multiple recipients are enhanced dramatically.

Dodd's FIG. 1B fails to show the creating a plurality of envelopes and displaying each envelope on a user interface so that items can be selected and moved into each envelope. This is needed when multiple recipients are to receive prints.

In contrast, the allegedly equivalent Dodd "envelopes" are not envelopes, but are icons designed in advance and the user has to select one item at a time into a shopping bag for a user. First, even if each envelope were equivalent to a shopping cart or shopping bag as noted in the Office Action, Dodd fails to show creating a plurality of

envelopes and displaying each envelope on a user interface. In Dodd, the user interface is predefined by a web designer and the user has no choice in creating and displaying envelopes on the user interface. This is one basis for traversing the rejection.

Further, Dodd shows one envelope that can receive one item at a time. For example, as noted in Col. 4, lines 35-42, FIG. 1B notes that "additional information about the earrings is displayed in content area 120. If the user (i.e., the gift giver) thinks that the earrings will make an appropriate gift for the recipient, the user enters a quantity amount in field 135 and positions the pointing device over a button 130 to add the gift item to the user's "shopping bag." In this manner, the user can select one of the gift items from a variety of gift items from one or more vendors."

The "shopping bag" analogy of FIG. 1B is completely different from the claimed envelopes which allow one or more recipients to receive items. Dodd's FIG. 1C also fails to show the creating a plurality of envelopes and displaying each envelope on a user interface as characterized in the Office Action where each envelope corresponds to a shopping cart. Although a number of catalog items are shown, each catalog item is not a shopping cart using the Office Action analogy. FIG. 1C shows another conventional ordering system in that the user can select one recipient to receive one selected gift item.

As explained in Dodd's Col. 4, line 53- Col. 5, line 28:

FIG. 1C illustrates an exemplary display of scheduled gift events, such as gift selections for multiple recipients related to future birthdays and holidays.

As previously mentioned, when the exchangeable fulfillment option is selected, the user is able to create an online exchangeable gift for the recipient. Additionally, the gift selection and notification can be customized with features, such as including a special or personalized multimedia message and multimedia greeting along with information about the selected gift. Typically, the recipient receives notification through electronic mail that a gift selection has been made for them. The notification may include instructions to connect to the gift server node, such as "Click on this Link to find out more about your gift."

In one embodiment, the recipient may be automatically associated with the appropriate gift order information due to an identifier associated with the recipient. In such a situation, the gift server node automatically determines it is the recipient who has connected to it from the recipient's network ID or recipient's IP address that is part of any message being sent from the recipient to the gift server node. Thus, in this embodiment, the identifier is any information (such as the recipient's network ID or IP address) that is automatically determinable by the gift server node to identify the recipient and match it with the appropriate gift order information.

In another embodiment, the identifier may be a predetermined name, number, code, or any other type of identification information provided by the gift server node in the notification associated with the order information intended for the recipient. Thus, if the recipient later connects to the gift server node and the recipient manually provides the identifier back to the gift server node, the gift server uses the identifier to obtain the order information intended for the recipient. Typically, the identifier is simply the recipient's electronic mail address or a predetermined order confirmation number. For example, the recipient may receive the notification (which includes the identifier, e.g., an order number, to be used when claiming the online gift), later connect to the gift server node and enter the identifier within a text field so that the gift server can search for and find the appropriate order information associated with the recipient.

Although Dodd mentions that gift selections for multiple recipients can be done, Dodd must operate on each recipient one at a time. There is no showing that Dodd associates with each envelope an intended recipient to receive images placed in a respective envelope. This is an independent basis to traverse the Section 102 rejection.

Further, Dodd does not show selecting an image for distribution to multiple recipients. At best, FIG. 1C shows that each item in the matrix can be associated with one recipient at a time since the "Select Recipient" drop down selection tab allows only one recipient to be selected at a time. This is yet another independent basis to traverse the Section 102 rejection.

In addition, Dodd fails to show "associating a selected image with two or more envelopes." FIG. 1C shows a number of images, but does not show two or more envelopes. If each envelope were a shopping cart (as asserted by the Office Action), there is no showing in Dodd that a plurality of shopping carts are available for selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes.

Thus, it is quite clear that Dodd fails to show each and every element of claim 31 and thus cannot anticipate claim 31. For claim 32, since Dodd shows only one shopping cart, Dodd cannot show displaying along with each envelope an identifier associated with the name of a recipient. Similarly, for claim 33, Dodd fails to show displaying along with each envelope a running price associated with the total price of images placed in a respective envelope. For claim 34, Dodd does not show a checkbox with each image, the checkbox for designating an image to be included in an order as FIG. 1B's 130 is a button, not a checkbox. For claim 35, Dodd fails to show placing an instance of the

image in each envelope associated with an intended recipient since Dodd has only one shopping cart. For claim 36, Dodd fails to show an add button or link associated with each envelope, the add button, when invoked, operable to add a copy of each selected image to a respective envelope. For claim 37, Dodd fails to show selecting an add button or link associated with an envelope of an intended recipient. As to claim 51, Dodd fails to show processing all of the envelopes as a single order since Dodd has only one shopping cart. For claim 52, Dodd does not show email confirmation with a summary of each envelope since Dodd has only one shopping cart. Withdrawal of the Section 102 rejection on all claims is requested.

The Section 103 Rejection

Claims 33, 38-40 and 53-54 were rejected under Section 103(a) as unpatentable over Dodd in view of Official Notice. As discussed above, Dodd fails to show creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes. Hence, the independent claims are patentable over Dodd and the dependent claims are allowable on this basis. As to the Official Notice, references should be provided or the rejection based on the Official Notice be withdrawn.

Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Dodd reference so as to produce the claimed invention. In fact, the Dodd reference teaches away from Applicants' invention as one skilled in the art would have been generally discouraged from using shopping carts to provide creating a plurality of envelopes and displaying each envelope on a user interface; associating with each envelope an intended recipient to receive images placed in a respective envelope; displaying on the user interface one or more images along with the plural envelopes; selecting an image for distribution to multiple recipients; and associating a selected image with two or more envelopes.

Applicant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Dodd, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claims 33, 38-40 and 53-54. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Dodd reference, or knowledge of those skilled in the art, to perform the recited claim operation, *prima facie* obviousness of the rejected claims has not been established. As such, it is respectfully requested that the § 103 rejection be withdrawn and the claims be allowed.

CONCLUSION

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Regards,



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